UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/509,180	04/27/2005	Michal Eisenbach-Schwartz	EIS-SCHWARTZ35	5208

1444 7590 12/18/2008

BROWDY AND NEIMARK, P.L.L.C.
624 NINTH STREET, NW
SUITE 300
WASHINGTON, DC 20001-5303

EXAMINER	
HILL, KEVIN KAI	
ART UNIT	PAPER NUMBER
1633	
MAIL DATE	DELIVERY MODE
12/18/2008	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/509,180	EISENBACH-SCHWARTZ ET AL.	
	Examiner	Art Unit	
	KEVIN K. HILL	1633	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 10 November 2008 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires *6* months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
   (a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);
   (b) ☐ They raise the issue of new matter (see NOTE below);
   (c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
   (d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

   NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☐ Applicant's reply has overcome the following rejection(s): _____.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☐ will not be entered, or b) ☒ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
   The status of the claim(s) is (or will be) as follows:
   Claim(s) allowed: _____.
   Claim(s) objected to: _____.
   Claim(s) rejected: *42-43*.
   Claim(s) withdrawn from consideration: *37,40 and 41*.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.

12. ☐ Note the attached Information *Disclosure Statement*(s). (PTO/SB/08) Paper No(s). _____

13. ☐ Other: _____.

/Q. JANICE LI, M.D./
Primary Examiner, Art Unit 1633

Continuation of 11. does NOT place the application in condition for allowance because:
Claims 42-43 stand rejected for reasons of record. Applicant requests reconsideration after Final Office Action.
Applicant argues that:
a) Sing is specifically directed to the treatment of autoimmune uveitis, and does not teach that the peptide of SEQ ID NO:5 is capable of blocking intraocular inflammation;
b) glaucoma is not an auto-immune disease; whereas, Singh only teaches the treatment of autoimmune diseases;
c) while it may have been obvious to use an altered S-Ag peptide for treatment of autoimmune uveitis, an autoimmune disease of the eye caused by S-Ag antigen, the instant invention is the use of S-Ag peptide for the treatment of non-autoimmune uveitis;
d) neither Singh nor other artisans teach or suggest that S-Ag peptide may be used to treat a disease of the same organ that is not an autoimmune disease, and thus the ordinary artisna had no good reason to pursue such option because such option was not available in the art; and
e) the peptide of Singh is not one of a finite number of identified predictable solutions applied to the treatment of a non-autoimmune disease.

Applicant's argument(s) has been fully considered, but is not persuasive.
With respect to a-e), in response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See In re Keller, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); In re Merck & Co., 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Schori et al teach that glaucoma is a chronic condition of the optic nerve, often associated with increased intraocular pressure (IOP). It is common experience that the disease may continue to progress even though the IOP remains within the normal range, suggesting that mechanical compression is probably not the sole reason for optic nerve damage, and that treatment should therefore include neuroprotective [peptide immunization] therapy (pg 3403, col. 2, last ¶). Schori et al teach substituting a first peptide for a second peptide to assay for a beneficial effect (pg 3400, col. 1, ¶5), thereby demonstrating that it is routine for the artisan to substitute different peptides to solve a problem, to wit, treating a disease, disorder or injury in the eye, wherein said disease, disorder or injury is other than an autoimmune disease of the eye. Schori et al also teach the selection of a peptide previously shown to achieve a beneficial immune response towards an autoimmune disease, i.e., multiple sclerosis, and previously shown to boost neuroprotection in a rodent optic nerve model (pg 3401, col. 1, ¶1). Thus, Schori et al teach that it is routine for the ordinary artisan to try substituting an identified predictable solution from an auto-immune disease model, as applied to treating a non-autoimmune disease. Singh et al teach that the peptide of SEQ ID NO:5 is an identified predictable solution from an auto-immune disease model. Thus, it is the Examiner's position that it would have been not only obvious but also common sense to the ordinary artisan to try substituting the peptide of SEQ ID NO:5 for a peptide of Schori et al in a method to treat a disease, disorder or injury in the eye, wherein said disease, disorder or injury is other than an autoimmune disease of the eye with a reasonable expectation of success because Schori et al successfully demonstrated not only that peptide substitution is routine, but also that a peptide previously shown to achieve a beneficial response towards an autoimmune disease could also achieve a beneficial response towards a non-autoimmune disease.